UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,595	03/29/2004	David Langley	50325-0866	3227

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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/812,595	LANGLEY ET AL.
	Examiner	**Art Unit**	
	Zarni Maung	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 March 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-23</u> is/are pending in the application.

    4a) Of the above claim(s) <u>1-5</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) <u>6-23</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>2/7/05</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   Office Action Summary   Part of Paper No./Mail Date 20070904

This action is responsive to the application filed on March 29, 2004. Claims 1-23 are

presented for examination.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-5 are directed to an apparatus for retrieving Permanent Virtual Channel

(PVC) configuration information from a network device coupled to the apparatus,

wherein the PVC configuration information specifies one or more PVCs defined for the

network device, the apparatus comprising: a PVC configuration parameter storage

means, request generator means, at least one request for PVC configuration

information and providing at an input/output logically configured into the at least one

logical interface and a response receiver means having first input coupled to the

network protocol adapter means, at least a portion of the PVC configuration information

to be selectively deleted from the PVC configuration parameter storage means

classified in Class **709**, subclass **220**.

II.   Claims 6-23 are directed to an apparatus for retrieving Permanent Virtual

Circuit (PVC) configuration information from a network device in a communications

network, wherein the PVC configuration information specifies one or more PVCs

defined for the network device, the apparatus comprising: a request generator, a

physical interface logically configured into a logical main interface and a plurality of

logical sub-interfaces, a comparator configured to compare the VPI from the message

to a first logical sub-interface number of a first logical sub-interface from the plurality of

logical sub-interfaces; and if the VPI from the message matches the first logical sub-

interface number of the first logical sub-interface, then cause the PVC configuration information from the message to be selectively stored into a first portion of a PVC configuration information storage that is designated for the first logical sub-interface, classified in Class **370,** subclass 395.31.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the Group I invention does not require <u>a comparator configured to compare the VPI from the message to a first logical sub-interface number of a first logical sub-interface from the plurality of logical sub-interfaces; and if the VPI from the message matches the first logical sub-interface number of the first logical sub-interface.</u> The subcombination has separate utility such as <u>a comparator configured to compare the VPI from the message to a first logical sub-interface number of a first logical sub-interface from the plurality of logical sub-interfaces</u>

For example, the searches for the two inventions would not be co-extensive because these groups would require different searches on PTO's classification class and subclass as following:

(a) the Group I search (claims 1-5) would require the use of search class **709**,

subclass **200** (which would not required for the group II).

(b) the Group II search (claims 21-30) would require the use of search class **370**,

subclass **359.31** (which would not required for the group I).

1.   During a telephone conversation with Mr. Edward A. Backer (Reg. Number

37,777) on September 4, 2007 a provisional election was made without traverse to

prosecute the invention of Group II, claims 6-23. Affirmation of this election must be

made by applicant in replying to this Office action. Claims 1-5 are withdrawn from

further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-

elected invention.

Applicant is advised that the response to this requirement to be complete <u>must</u>

include an election of the invention to be examined even though the requirement be

traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected

invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if

one or more of the currently named inventors is no longer an inventor of at least one

claim remaining in the application.   Any amendment of inventorship must be

accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee

required under 37 C.F.R. § 1.17(h).

>   The nonstatutory double patenting rejection is based on a judicially created
> doctrine grounded in public policy (a policy reflected in the statute) so as to
> prevent the unjustified or improper timewise extension of the "right to exclude"
> granted by a patent and to prevent possible harassment by multiple assignees.
> A nonstatutory obviousness-type double patenting rejection is appropriate where
> the conflicting claims are not identical, but at least one examined application
> claim is not patentably distinct from the reference claim(s) because the examined
> application claim is either anticipated by, or would have been obvious over, the
> reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed.
> Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In
> re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686
> F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ
> 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA
> 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2.   Claims 6-23 are rejected on the ground of nonstatutory double patenting over

claims 1-27 of U: S. Patent No. 6,700,890 (hereinafter '890 patent) since the claims, if

allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the

patent and is covered by the patent since the patent and the application are claiming

common subject matter, as follows:

Taking claim 6 as an exemplary claim, claim 1 of the '890 patent discloses a method which is parallel to that of the apparatus claim 6 in is application. Claim 1 of the patent recites

> 1. A method of retrieving Permanent Virtual Circuit (PVC) configuration information from a network device in a communications network, wherein the PVC configuration information specifies one or more PVCs defined for the network device, the method comprising the computer-implemented steps of:
> generating and providing to the network device a request for PVC configuration information stored in the network device;
> receiving, over a physical interface logically configured into a logical main interface and a plurality of logical sub-interfaces, a message containing both the PVC configuration information stored in the network device and a Virtual Path Identifier (VPI), wherein the VPI and a VCI uniquely identify a PVC associated with the PVC configuration information;
> comparing the VPI from the message to a first logical sub-interface number of a first logical sub-interface from the plurality of logical sub-interfaces;
> if the VPI from the message matches the first logical sub-interface number of the first logical sub-interface, then causing the PVC configuration information from the message to be selectively stored into a first portion of a PVC configuration information storage that is designated for the first logical sub-interface; and
> if the VPI from the message does not match the first logical sub-interface number of the first logical sub-interface, then causing the PVC configuration information from the message to be selectively stored into a second portion of the PVC configuration information storage that is designated for the logical main interface.

Claim 6 or the present application recited an apparatus comprising all of the above limitations recited in the '890 patent (See claim 6). The dependent claims 7-14 are directed to the same limitations in 2-18 of '890 patent. The limitations recited in claims 15-23 of the present application are parallel to that of limitations recited in claims 19-27 of the '890 patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zarni Maung whose telephone number is (571) 272-3939. The Examiner can normally be reached on Monday-Friday from 8:30 to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Valencia Martin-Wallace can be reached at (571) 272-3440. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see http://pair-direct.uspto.gov or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

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ZARNI MAUNG
PRIMARY EXAMINER